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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,470	07/25/2003	Jorg Kroker	5857	3226

7590

09/26/2005

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EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,470

Applicant(s)

KROKER ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/1/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-11 are now pending in the application.
2. All outstanding objections to the specification and claims and 35 USC 112, 1st and 2nd paragraph claim rejections are withdrawn in light of applicant's amendment filed 8/1/2005.
3. The 35 USC 103(a) rejections over Woodson '576 (US 4,806,576) in view of Kwasniok et al (DE 19727540) and further in view of *Hawley's* ("oleic acid" and/or "casting") (paragraph 12 of Office action mailed 1/12/2005) and Kwasniok et al (DE 19727540) in view of Aizpura et al and further in view of *Hawley's* ("oleic acid" and/or "casting") (paragraph 4 of Office action mailed 2/9/2005) are withdrawn in light of applicant's arguments filed 8/1/2005 and the cancellation of claims 12 and 13.
4. The 35 USC 103(a) rejection over U.S. Patent No. 6,604,567 is withdrawn in view of the statement of common ownership at the time of the invention by David L. Hedden in the declaration filed under 37 CFR 1.132 filed 8/1/2005.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
6. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 8/1/2005. In particular, claim 3 has been amended to recite the range "about 165 to about 250 grams per equivalent". Thus, the following action is properly made final.

Information Disclosure Statement

7. The Information Disclosure Statement (IDS) filed 8/1/2005 has been fully considered, however, the cited documents are not published U.S. patent documents and have been struck

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from the IDS. The corresponding U.S. Pre-Grant Publications have been cited by the examiner on US form-892 (US 2005/0020725, US 2005/0020727, and US 2005/0020726 for 10/627,471, 10/628,056, and 10/628024, respectively).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 3 has been amended to recite the range of about 165 to about 200 grams per equivalent. It is the examiner's position that this phrase fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the term "about" associated with the number 200 in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed. While there is support for "200 grams.equivalent" on page 6, line 10 of the specification, there is no support for the term "about".

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Claim Rejections - 35 USC § 102

9. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Woodson et al '567 (US 6,604,567).

The rejection is adequately set forth in paragraph 6 of Office action mailed 1/12/2005 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

10. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodson '576 (US 4,806,576, cited on IDS dated 7/25/2003) in view of Kwasniok et al (DE 19727540, cited on IDS dated 7/25/2003).

The rejection is adequately set forth in paragraph 7 of Office action mailed 1/12/2005 and is incorporated here by reference.

11. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwasniok et al (DE 19727540) alone or Kwasniok et al in view of Aizpurua et al (*J. Appl. Poly. Sci.*, Vol. 76, 1269-1279).

The rejection is adequately set forth in paragraph 2 of Office action mailed 2/9/2005 and is incorporated here by reference.

Double Patenting

12. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,604,567. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

The rejection is adequately set forth in paragraph 10 of Office action mailed 1/12/2005 and is incorporated here by reference.

Response to Arguments

13. Applicant's arguments filed 8/1/2005 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Woodson et al '567 does not anticipate the presently claimed invention since there are no examples in Woodson et al '567 that utilized an C₄-C₈ alkyl ester and since Woodson discloses that the solvent is not required; (B) that unexpectedly improved properties are had when the presently claimed ester is used; (C) that Kwasniok (DE '540) teaches away from using alkyl esters having more than 3 carbon atoms in the alkyl group and that *In re Wilder* is non-analogous case since it involves a compound and not a composition with a compound;

With respect to argument (A), while Woodson does not exemplify the use of the presently claimed ester, case law holds that "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Moreover, given that a reference that clearly names a claimed species anticipates that species no matter how many additional species are named, it is clear that the explicit disclosure of butyl tallate anticipates the presently cited claims. See MPEP § 2131.02. In addition, while the use of a solvent such as butyl tallate is not required, Woodson et al '567 does disclose embodiments with

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solvent since the range of 0-25 weight % with amounts greater than 0 wt % is also disclosed (col. 4, line 41).

With respect to argument (B), applicant's data in Table III on page 15 of the specification has been considered, however, a claim of unexpected results cannot be established for the claimed composition since the inventive examples only include butyl and isooctyltallate, i.e., the examples only establish an unexpected property for tallate and not all fatty acid esters like presently claimed. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983).

With respect to argument (C), while Kwasniok does not explicitly disclose an alkyl with 4 to 8 carbon atoms, it hardly teaches away from higher alkyl esters. Note that Kwasniok does not dissuade from the use of other alkyl esters and it is still the examiner's position that higher alkyl groups in the fatty acid ester would be expected to exhibit the same advantageous properties of an alkyl with 1-3 carbon atoms, absent evidence to the contrary. While *In re Wilder* case law is to a compound, it states that "[w]hen expectation of similar properties stands un rebutted, it necessarily follows that expectation of similar uses also stands un rebutted; expectation of similar use necessarily implies expectation of substantially equivalent substitute". In other words, a compound which is an obvious variant of the prior art would be expected to exhibit equivalent properties in a composition, absent evidence to the contrary. Applicant's examples do not support such a position since the data only compare butyl tallate and isooctyltallate with rapeseed methyl ester and methyl ester of soybean oil. No comparison is made between a C₃ and a C₄ alkyl.

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Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/19/2005

vr



CALLIE E. SHOSHO
PRIMARY EXAMINER